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10/029,313	12/28/2001	Dino M. Morson	D/A0865	3485

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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT PAPER NUMBER

3724

DATE MAILED: 01/05/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/029,313

Applicant(s)

MORSON, DINO M.

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 10-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

1. Claims 5-7 and 10-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

2. Applicant's election with traverse of Group I (claims 1, 2-4 and 8-9) in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the inventions are too similar to be separated. Further it is argued that newly added claims link the invention of the marking system and the hole punch apparatus. This is not found persuasive because proper restriction requirements can be shown by separate classification. In this case, Groups I-V require separate classification and searches, e.g., the invention of claims 26 and 28-29 require a search in classes 101, 271, 355, 358, and 399, while the invention of claims 2-4 and 8-9 require a search in class 83 only.

As to the new claims, the inventions of claims 28-29 and Group I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, e.g., the hole punch apparatus with marking system of claims 28-29 could be employed without the plurality of punches of Group I; conversely, the plurality of punches of Group I could be employed without the marking system of claims 28-29.

The requirement is still deemed proper and is therefore made FINAL.

***Oath/Declaration***

3. Upon review of the Declaration it was discovered that the clause referring to "the specification and claims of which" implies that the specification and claims were "filed on 12/28/02 as U.S. Application No. 10/029,313". This appears incorrect as the instant application has a filing date of 12/28/01. Please comment as to whether this is actually correct or not.

***Specification***

4. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

5. The abstract of the disclosure is objected to because the abstract should not refer to purported merits or speculative applications of the invention. Although the abstract should include a statement of the technical disclosure of the application that is

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new or improved over the prior art, it should not refer to purported merits or speculative applications of the invention. In this case, e.g., the abstract uses the phrases "An improved and more efficient device", which appears to refer to purported merits or speculative applications of the invention. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 102 & 103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Holzhauser et al., U.S. Patent 6,295,908.

Holzhauser discloses the same invention as claimed including, for example, a hole punch apparatus for perforating sheets in a sheet path comprising: a member rotatable (20) in the direction the sheet path; a first punch (one of the punches shown in

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Figures 1 and 2 as 22) attached to the member and positioned to intersect the sheet path when rotated to a position orthogonal to the sheet path (see Figure 1); a second punch (one of the punches shown in Figures 1 and 2 as 24) attached to the member, the second punch positioned to intersect the sheet path when rotated to a position orthogonal to the sheet path and positioned at an angle relative to the first punch (see Figures 1 and 2) such that when the either the first or second punch intersects the sheet path, the other punch is rotated to a position that does not intersect the sheet path; a drive mechanism (28/38/70/68) for powering the rotation of the member; and a controller (64) cooperating with the drive mechanism and capable of controlling the rotation of the member such that when one punch is selected for intersection with a sheet in the sheet path, the rotation is timed such that the other punch intersects the sheet path in a space between pitches (see column 2, lines 25-45; column 4, lines 1-15; column 4, lines 30-47; column 5, lines 9-40).

As to claim 2, the first punch includes multiple punches (see Figure 1).

As to claim 3, the second punch includes multiple punches (see Figure 1).

As to claim 4, there are two first punches and three-second punches (see Figure 1).

As to claim 8, the first and second punches are oriented 180 degrees from each other.

As to claim 9, a third punch (one of the punches 24) is included in the device (see Figure 1).

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9. Claims 1-4 and 8-9 are rejected under 35 U.S.C. 102(e) as anticipated by Japanese application 2000-169890, hereinafter JP '890, or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP '890 in view of Holzhauser.

JP'890 discloses the same invention as claimed including, for example, a hole punch apparatus for perforating sheets in a sheet path comprising: a member rotatable (10) in the direction the sheet path; a first punch (one of the punches shown in Figures 1 and 2 as 11a) attached to the member and positioned to intersect the sheet path when rotated to a position orthogonal to the sheet path (see Figure 1); a second punch (one of the punches shown in Figures 1 and 2 as 11b) attached to the member, the second punch positioned to intersect the sheet path when rotated to a position orthogonal to the sheet path and positioned at an angle relative to the first punch (see Figures 1 and 2) such that when the either the first or second punch intersects the sheet path, the other punch is rotated to a position that does not intersect the sheet path; a drive mechanism (26/28/28/17/15) for powering the rotation of the member; and a controller (41) cooperating with the drive mechanism and capable of controlling the rotation of the member such that when one punch is selected for intersection with a sheet in the sheet path, the rotation is timed such that the other punch intersects the sheet path in a space between pitches.

In the alternative, even if it is argued that JP '890 lacks the control for controlling the punches to selectively make different punched hole configurations in a sheet traveling in the sheet path, Holzhauser discloses that it is old and well known in the art to use controllers that control the rotation of the hole punches to make timed rotations

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such that both groups of punches do not intersect the sheet path for the purpose of creating different hole punch configurations. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a controller to control the rotation of the punch holder in order to provide different hole punch configurations in a sheet traveling in the sheet path.

As to claim 2, the first punch includes multiple punches (see Figure 1).

As to claim 3, the second punch includes multiple punches (see Figure 1).

As to claim 4, there are two first punches and three second punches (see Figure 1).

As to claim 8, the first and second punches are oriented 180 degrees from each other (see Figure 1).

As to claim 9, a third punch (one of the punches 11b) is included in the device (see Figure 1).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

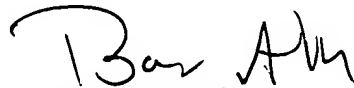
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
Monday, December 29, 2003